

REMARKS/ARGUMENTS

This response is accompanied by Request for a Two-Month Extension of Time and the necessary fee to extend the date for response until July 12, 2003.

Claims 27-31 are amended and Claim 30 is cancelled without prejudice in the subject application. Claims 1-29 and 31-32 remain pending in the subject application.

Claims 1-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw *et al.* (6,199,106).

With respect to claims 1-20, the Examiner states that “Shaw lacks an explicit recitation of ‘including a photographic likeness of the user; comparing the user profile, including information derived from the user’s likeness....’ even though Shaw.... suggests the same.”

Shaw *et al.* neither disclose nor suggest including a photographic likeness of the user; comparing the user profile, including information derived from the user’s likeness, as the examiner asserts. Shaw *et al.* only briefly mention the term “pictures” along with “sound recordings, formatted documents, etc.” in the Background of the Invention section in column 1, lines 24-26. The use of pictures in this context merely exemplifies the type of information that persons using a computer commonly send via email messages.

The Applicants traverse the entire line of reasoning of the Examiner. The Examiner contends that it would have been obvious at the time the Applicant’s invention were made to one of ordinary skill in the art in view of Shaw *et al.* to select user’s photographic likeness information because such a selection “... *allows users to view advertisements while receiving, composing, and managing personal electronic communications.*” This is found in Shaw *et al.* at col. 3, lines 5-10. However, the foregoing passage simply refers to the fact that an off-line user can view the advertisement at the user’s own time and convenience while receiving email and then the user at some time in the future can compose, i.e. write, email messages that are sent back to the remote system. There is nothing in such a passage to suggest the use of a photographic likeness of the user. Deriving information from a photographic likeness for purposes of targeting marketing content is certainly not suggested by the desire to allow users to view advertisements while using email.

In fact, the other passages cited by the Examiner direct one skilled in the art away from making a selection of the user's image. It is clear that the Examiner has used impermissible hindsight gained on reading the Applicants' invention to come up with such an unobviousness rejection. Reconsideration is respectfully requested.

The fact that Shaw *et al.* do not suggest the use of a photographic likeness of the user certainly means that this reference does not suggest the subject matter recited in claims 1-20, 24, 25, 26, and 27-32.

In reference to claims 21-26, the Applicants' have carefully read the entire Shaw *et al.* reference and find no suggestion of the claimed methods, which include the steps of assigning metrics to data elements in the user profile, each metric representing either an incremental or decremental change in a market segmentation variable, and including a factor that decays over time; calculating a user index by applying the assigned metrics to the market segmentation variables; and the subsequent steps recited in the method of claim 21.

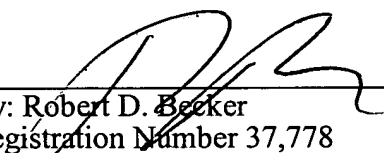
The Examiner contends that it would have been obvious that the "directory" disclosure of Shaw *et al.* would have been selected in accordance with an index because such selection would have provided means that "... *allows users to view advertisements while receiving, composing, and managing personal electronic communications.*" Applicant respectfully submits that the Examiner has failed to identify where the missing recited claim elements can be found in the prior art and further that the Examiner's reasoning is flawed. The term "directory" simply refers to a hierarchical structure to organize the storage of computer files onto a disk. There is no suggestion that would have motivated one of ordinary skill in the art to perform the steps of assigning metrics to data elements in the user profile, each metric representing either an incremental or decremental change in a market segmentation variable, and including a factor that decays over time, and there is no suggestion that would have motivated one of ordinary skill in the art to calculate a user index by applying the assigned metrics to the market segmentation variables.

The pending claims have been shown to be inventively and patentably distinguishable over Shaw *et al.* The Examiner is respectfully requested to reconsider and find these claims are now in a condition for allowance.

The Commissioner is hereby authorized to charge any additional fees to Manatt, Phelps & Phillips' Deposit Account No. 50-1847 or to credit any overpayment to the same for all matters during the prosecution of the subject application.

Respectfully submitted,

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APPENDIX A

MARKED UP VERSION OF AMENDED CLAIMS

Claim 27. (Once Amended): A method for targeting marketing content to an online user, each content having an associated target profile including at least one market segmentation variable and each online user having an associated user profile including a photographic likeness of the user and including a plurality of data elements, comprising the steps of:

collecting data describing the user in the user profile, the data including responses to context sensitive questions;

comparing the [user profile, including] information derived from the associated user's photographic likeness and the context sensitive questions, to the target profile associated with each content; and

presenting the user with content based on the comparison.

Claim 31. (Once Amended): The method of Claim [30] 27 wherein the photographic likeness is altered to incorporate a portion of the content into the photographic, likeness for display to the user.